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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,827

03/10/2004

Satoru Wakao

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7468

26272

7590

08/20/2008

COWAN LIEBOWITZ & LATMAN P.C.

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EXAMINER

REZA, MOHAMMAD W

ART UNIT

PAPER NUMBER

2136

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,827

Applicant(s)

WAKAO ET AL.

Examiner

MOHAMMAD W. REZA

Art Unit

2136

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the arguments filed on 05/29/2008.
2. Claims 1-3, 14-19 are pending in the application.
3. Claims 1-3, 14-19 have been rejected.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/29/2008 has been entered.

Response to Amendment

5. The examiner approves the amendments made to claims 1.
6. The examiner approves cancellation of claims 4-13, and 20-28.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-3, 14-19 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independent claim 1 has the limitations "a receiving unit that receives one of a first command and a second command, the first command including information indicating one of a plurality of secret keys". No where in figures and specification mentions the first command and second command. Specification has no support of the claim limitation, "the first command including information indicating one of plurality of secret keys."

Response to Arguments

8. Applicant's arguments with respect to claims 1-3, 14-19 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's response regarding the 112 first paragraph issue does not satisfy to withdraw the rejection. Applicant does not show where in the specification has support for "a receiving unit that receives one of a **first command** and a **second command**, the first command including information indicating one of a plurality of secret keys". So, examiner sustains the 112 first paragraph rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata et al hereafter Hirata (Foreign Patent application JP2002300150) in view of Kawakita et al hereafter Kawakita (Foreign Patent application JP10031326).

10. As per claim 1, Hirata discloses a digital signature generating apparatus comprising: a receiving unit that receives one of a first or command and a second command, a secret key changing unit that changes a secret key used by the digital signature generating apparatus to a secret key specified by the first command, if the first command is received by the receiving unit (page 2, paragraphs, 0005, abstract, claim 1); and a digital signature generating unit that generates the digital signature of the digital data using the second secret key specified by the first command, if the second command is received by the receiving unit (page, 2, paragraphs, 0007-0008, claim 3). Although, Hirata discloses the secret key will stored beforehand (paragraph 0005), he does not expressly disclose that the plurality of secret keys being included in the apparatus. However, in the same field of endeavor, Kawakita discloses the first command including information indicating one of a plurality of secret keys, the plurality of secret keys being included in the apparatus (page, 2, 0003-0009, 0020-0022) and a

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secret key changing unit that changes a secret key used by the digital apparatus to a secret key specified by the first command (page, 3, paragraphs, 0015-00222, 0033-0034).

Accordingly, it would be obvious to one of ordinary skill in the network security art at the time of invention was made to have incorporated Kawakita's teachings of plurality of secret keys being included in the apparatus with the teachings of Hirata, for the purpose of suitably using the key changing technique among the plurality of stored secret keys.

11. As per claim 2, Hirata discloses the digital signature generating apparatus is an IC card (paragraph, 0007).

12. As per claim 3, Hirata discloses the digital signature generating apparatus wherein the digital signature generating apparatus is an apparatus including a multi-application operating system (paragraphs, 0005-0007).

13. As per claim 14, Hirata discloses the digital signature generating apparatus wherein a storage unit that stores the plurality of secret keys (paragraphs, 0005).

14. As per claim 15, Hirata discloses the digital signature generating apparatus wherein the digital data includes image data (paragraphs, 0008-0010).

15. As per claim 16, Hirata discloses the digital signature generating apparatus wherein the receiving unit receives the digital data from an external device, the digital data being used to generate the digital signature of the digital data (paragraph, 0004-0006).

16. As per claim 17, Hirata discloses the digital signature generating apparatus wherein the digital signature generating unit generates a hash value of the digital data

from the digital data in order to generate the digital signature of the digital data (paragraphs, 0006-0008).

17. As per claim 18, Hirata discloses the digital signature generating apparatus wherein the digital signature generating unit encrypts the hash value of the digital data using the secret key specified by the first command, in order to generate the digital signature of the digital data (page 2, paragraphs, 0005, abstract, claim 1).

18. As per claim 19, Hirata discloses the digital signature generating apparatus wherein the receiving unit receives a hash value of the digital data from an external device, the hash value being used to generate the digital signature of the digital data (paragraphs, 0005-0009).

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad w. Reza whose telephone number is 571-272-6590. The examiner can normally be reached on M-F (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MOAZZAMI NASSER G can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Nasser G Moazzami/

Mohammad Wasim Reza

Supervisory Patent Examiner, Art Unit 2136

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